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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,229	01/14/2004	Brandon Rogers	DAY 0807 VA/40195.817	3259
7590 09/27/2006			EXAMINER	
DINSMORE & SHOHL LLP One Dayton Centre Suite 500 One South Main Street Dayton, OH 45402-0724			SAN MARTIN, EDGARDO	
			ART UNIT	PAPER NUMBER
			2837	
DATE MAILED: 09/27/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/757,229	<b>Applicant(s)</b> ROGERS ET AL.	
	<b>Examiner</b> Edgardo San Martin	<b>Art Unit</b> 2837	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                        |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____.  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1 – 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mahl (US 3,998,347) in view of Caldwell et al. (US 3,160,549), and further in view of Gold (US 5,150,943).

With respect to claims 1 and 8, Mahl teaches a flexible polymeric material having a finite length, a generally J-shaped configuration when viewed from an end thereof (Fig.2, Item 22), and having inner and outer surfaces, at least a portion of the inner surface of the J-shaped configuration including an adhesive thereon (Fig.5, Item 40) (Col.1, Line 60 – Col.2, Line 5, Col.2, Lines 37 – 40 and Lines 61 – 63), but fail to disclose wherein the strip of flexible polymeric material is used as a sound dampening pad, the generally J-shaped configuration being curved, the inner surface comprising the inner radius of the J-shaped configuration and the outer surface comprising the outer radius of the J-shaped configuration, and the adhesive is a pressure sensitive adhesive.

Nevertheless, Caldwell et al. teach a sound dampening member (Fig.1, Item 13) including a pressure sensitive adhesive (Fig.1, Item 11 and Fig.2) thereon, and wherein flexible polymeric material being used as sound dampening elements (Col.1, Line 11 –

Col.3, Line 57). In addition, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex Parte Masham*, 2 USPQ F.2d 1647 (1987).

On the other hand, Gold teaches a flexible polymeric material having a generally J-shaped configuration when viewed from an end thereof (Fig.3, Item 24), and having inner and outer surfaces, the inner surface comprising the inner radius of the J-shaped configuration and the outer surface comprising the outer radius of the J-shaped configuration, at least a portion of the surface of the J-shaped configuration including an adhesive thereon (Fig.3, Item 36) (Col.2, Lines 9 – 15 and 21 - 27); in addition, it has been held by the courts that a change in shape or configuration is nothing more than one of numerous shapes that one of ordinary skill in the art will find obvious to provide based on the suitability for the intended final application. See *In re Dailey*, 149 USPQ 47 (CCPA 1976).

It would have been obvious to a person with ordinary skill in the art at the time of the invention was made to employ the Caldwell et al. pressure sensitive adhesive and the Gold curved configuration with the Mahl flexible polymeric material design because the Caldwell et al. pressure sensitive adhesive it would provide the sound dampening pad with a ready-to-lay convenience that is easily applicable and well adapted for manual application, eliminating a time consuming application of an adhesive at the time of attachment to an element to be damped, the Gold curved configuration would provide

a material that enables the strip to match, as required, the curved and bent shape of the element where the strip is going to be mounted.

With respect to claim 2, Mahl teaches flexible polymeric material strip comprises natural or synthetic rubber or a thermoplastic polymer (Col.2, Lines 37 - 40).

With respect to claims 3 - 5, Caldwell et al. teach in which the pressure sensitive adhesive comprises a double-sided adhesive tape (Fig.1; Col.2, Line 70 - Col.3, Line 30), in which the exposed surface of the double-sided adhesive tape includes a release liner (Fig.2, Item 23) thereon, and in which the double-sided adhesive tape includes a foam core (Fig.2, Item 21).

With respect to claims 6 and 7, Mahl teaches in which the adhesive is mounted on the longer leg (Fig.5, Item 24) of the J-shaped configuration, and in which the shorter leg of the J-shaped configuration has a length such that the shorter leg does not extend to the pressure sensitive adhesive (Fig.5; Col.2, Lines 61 - 63).

With respect to claim 9, Gold teaches wherein the curved configuration comprises a U-shaped configuration (Fig.3).

### ***Response to Arguments***

2. Applicant's arguments filed on July 6, 2006 have been fully considered but they are not persuasive. The Examiner still considers that the obvious combination of the patents to Mahl, Caldwell et al. and Gold teach the limitations described in the claims, as discussed above. In response to applicant's argument that Mahl, Caldwell et al. and

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Gold are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Mahl, Caldwell et al. and Gold are directed to a flexible polymeric material attached to an element in order to dampened vibrations generated in the element. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Finally, it has been held that

rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70.

### ***Conclusion***

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Contact Information***

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edgardo San Martin whose telephone number is (571)272-2074. The examiner can normally be reached on 8:00AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Bradley can be reached on (571) 272-2800 ext.33. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Edgardo San Martín  
Primary Examiner  
Art Unit 2837  
Class 181  
September 20, 2006